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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,225	09/25/2001	Laurence S. Sloman	A01P1032	1849
7590	05/18/2004		EXAMINER	
PACESETTER, INC. 15900 Valley View Court Sylmar, CA 91392-9221			OROPEZA, FRANCES P	
			ART UNIT	PAPER NUMBER
			3762	C
			DATE MAILED: 05/18/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/964,225	SLOMAN ET AL.
	Examiner	Art Unit
	Frances P. Oropeza	3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 2/26/04 (Amendment).
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. Claims 1-5 and 8-26 stand rejected under 35 U.S.C. 102(e) as being anticipated by Schloss (US 6456882).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Schloss discloses an implantable stimulator with automatic capture and threshold capability using counts of the primary stimulation pulses and the back-up stimulation pulses to evaluate the performance of the auto-capture feature. The safety margin is adjusted, hence impacting the stimulation pulse output settings. The amplitude and duration of the primary pulses are varied. Bins in memory, associated with parameters such as output setting, are used to store separate event data. The data is displayed as a histogram (abstract; col. 2 @ 3-11; col. 3 @ 4-41; col. 4 @ 17-31; col. 5 @ 26-39; col. 6 @ 42 – col. 7 @ 15; col. 7 @ 28-39 and 45-60; col. 11 @ 11 – col. 12 @ 44; col. 13 @ 22-33).

The Applicant’s comments have been fully considered but they are not convincing.

The Applicant states the Schloss reference does not qualify as prior art for a rejection under both 25 U.S.C. 102(e) and 35 U.S.C. 103(a) via 35 U.S.C. 102(e) because the present

application has been filed on or after November 29, 2000 and the subject matter of the Schloss reference and the pending claims were, at the time the invention was made, subject to an obligation of assignment to the same organization.

The Examiner is unfamiliar with this ruling and hence disagrees with the Applicant's statement.

The Examiner offers the following understanding of the regulations. The instant application was filed on or after November 29, 1999, hence the 35 U.S.C. 103(c) exclusion would apply if the rejection in the application was a 35 U.S.C. 103(a) rejection. The 35 U.S.C. 103(c) exclusion relates to a rejection under 35 U.S.C. 103(a) using a 35 U.S.C 102(e) reference that is commonly owned with the instant invention. In this situation, the Applicant need only make a simple statement regarding the common ownership, and the 35 U.S.C. 103(a) rejection based on the commonly owned 35 U.S.C. 102(e) reference is overcome. In the case of the instant invention, while the instant invention and the Schloss invention were commonly owned, the rejection of record was under 35 U.S.C 102(e). To overcome a rejection under 35 U.S.C. 102(e) when there is common ownership of subject matter, the Applicant must:

- 1) persuade the Examiner the rejection is incorrect, 2) amend the claim to make the rejection inapplicable, 3) show under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or 4) provide by an appropriate showing under 37 CFR 1.131. Since it is deemed the Applicant has not properly challenged the rejection of record, the rejection of record stands.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schloss (US 6456882) in view of Stessman (US6584355). As discussed in paragraph 3 of this action, Schloss discloses the claimed invention except for using the historical frequency of occurrence of the primary and back-up pulse to determine an expected remaining life of a power source (claim 6), and the integrity of the stimulation device (claim 7).

Stessman teaches the determination of device status using the frequency of occurrence of the primary and back-up pulse for the purpose of determining an expected remaining life of a power source and determining the integrity of the stimulation device. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the

frequency of occurrence of the primary and back-up pulse for the purpose of determining an expected remaining life of a power source and determining the integrity of the stimulation device in the Schloss system in order to use the battery and integrity data to adjust the device parameter using telemetry to optimize the performance of the device, and to monitor and optimize device longevity so the device can be safely used for as long a period as possible prior to replacement (abstract; col. 1 @ 7-57; col. 2 @ 5-19; col. 9 @ 14 – col. 10 @ 35).

Statutory Basis

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3762

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frances P. Oropeza whose telephone number is (703) 605-4355. The examiner can normally be reached Monday through Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes, can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520. The telephone number for facsimiles for regular communication and After Final communications is (703) 872-9306

Any inquiry of a general nature, relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

JPO
5/16/04

Angela D. Sykes

ANGELA D. SYKES
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